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**BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES**

Application Number: 10/718,481  
Filing Date: November 19, 2003  
Appellant(s): CASTO ET AL.

**MAILED**  
NOV 15 2007  
**GROUP 2600**

Patrick M. Boucher  
For Appellant

**EXAMINER'S ANSWER**

This is in response to the appeal brief filed August 6, 2007 appealing from the Office action mailed February 8, 2007.

**(1) Real Party in Interest**

A statement identifying by name the real party in interest is contained in the brief.

**(2) Related Appeals and Interferences**

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

**(3) Status of Claims**

The statement of the status of claims contained in the brief is correct.

**(4) Status of Amendments After Final**

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

**(5) Summary of Claimed Subject Matter**

The summary of claimed subject matter contained in the brief is correct.

**(6) Grounds of Rejection to be Reviewed on Appeal**

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

**(7) Claims Appendix**

The copy of the appealed claims contained in the Appendix to the brief is correct.

**(8) Evidence Relied Upon**

The following is a listing of the prior art of record relied upon in the rejection of claims under appeal.

6,557,758 B1	Monico	5-2003
6,398,109 B1	Ohki	6-2002
5,929760	Monahan	7-1999
5,776,278	Tuttle	7-1998
US 2003/0057276 A1	Appalucci et al.	3-2003

**(9) Grounds of Rejection**

The following ground(s) of rejection are applicable to the appealed claims:

Claims 1-2, 5-10 and 26-28, are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent 6,557,758 {hereinafter 'Monico'} in view of US Patent 6,398,109 {hereinafter 'Ohki'}.

In claim 1, Monico teach of a method for automated preparation of radio-frequency devices 21 for distribution, the method comprising:

In box 10 shown in Figure 1: receiving a radio-frequency device, the device comprising an embedded radio-frequency transponder (i.e. RFID tag 22). Although Monico does not disclose a plurality of RFID tags, it would have been obvious to one of ordinary skill in the art, at the time of applicant's invention, to include a plurality of RFID tags in the package delivery of Monico because when there are a plurality of packages to be delivered, the plurality of packages will require a plurality of RFID tags;

sequentially moving each of the radio-frequency devices to a plurality of stations (i.e. boxes 10, 11, 12, 13) of a preparation device shown in Figure 1;

In box 13: encoding, at a first station, a radio-frequency identification code (i.e. serial number, coded information, shipping and tracking data) assigned to the each of the radio-frequency devices {col. 3, lines 39-47};

identifying (i.e. reading and checking) a recipient for the each of the radio-frequency devices {col. 4, lines 44-54}; and

In box 12 or 17: labeling, at a second station, a package containing the each of the radio-frequency devices with a mailing address for the recipient {paragraph bridging cols. 3 and 4}.

Although Monico does not disclose expressly "a second station different from the first station", these features are conventional in automated packaging facilities where a physical distribution system maintains a high degree of secrecy, as evidenced by Ohki. Ohki, in an analogous art, teach of a method for automated package handling system wherein a second station (i.e. conveying trade B or receiving trade C) is different from a first station (i.e. sending

trade A), as shown in Figure 1. Ohki suggests that labeling (i.e. writing information) about the physical distribution situation of the article, such as address of the receiving trade C at the conveying trade B (second station different from the first station) is advantageous (see Ohki, col. 5, lines 53-59), because a high degree of secrecy can be maintained (see Ohki, col. 1, lines 52-58+). In this case, the paper slip 32 containing names of the destination (receiving trade C) is made secret to the personnel at sending trade A (i.e. packaging area) instead of being displayed (see Ohki, col. 3, lines 55-65). Therefore, it would have been obvious to one of ordinary skill in the art, at the time of applicant's invention, to include "labeling at a second station different from the first station" in the system of Monico because, as taught by Ohki, it maintains a high degree of secrecy.

In claim 2, the method recited in claim 1 further comprising: reading, at a third station, the radio-frequency identification code from each of the radio-frequency devices {see Monico, col. 4, lines 46-50}; and verifying (i.e. checking) at a third station (i.e. various locations including destination and any transfer points) different from the second station that the read radio-frequency identification code matches the assigned radio-frequency identification code {see Monico, col. 4, lines 50-53+}.

In claims 5 and 6, the method recited in claim 1 wherein: In box 11: receiving the plurality of such radio-frequency devices comprises receiving each such device in an enclosure (i.e. package) as shown in Figure 2; and encoding the radio-frequency identification code is

performed without removing the each of the radio-frequency devices from the enclosure (see Monico, col. 4, lines 38-53).

In claim 7, the method recited in claim 1 further comprising encapsulating the each of the radio-frequency devices (i.e. product 21) in material (i.e. package 21) to produce a structure of a standard size (i.e. conventional structure) {see Monico, col. 3, lines 26-30+} as shown in Figure 2, wherein the preparation device is adapted to move objects of the standard size to the plurality of stations as shown in Figure 1.

In claim 8, the method recited in claim 7 wherein encapsulating the each of the radio-frequency devices comprises heat shrink wrapping (i.e. shrink-wrap plastic) the each of the radio-frequency devices {see Monico, col. 3, lines 26-27+}.

In claim 9, the method recited in claim 1 further comprising affixing (i.e. applied with a label, mixed, attached, etc.) {see Monico, col. 4, lines 17-22} the each of the radio-frequency devices 22 to a backboard 21 having a standard size (i.e. conventional structure) {see Monico, col. 3, lines 26-30+}, wherein the preparation device is adapted to move objects of the standard size to the plurality of stations as shown in Figure 1.

In claim 10, the method recited in claim 1 further comprising inserting the each of the radio-frequency devices into an envelope for mailing to the recipient {see Monico, col. 3, lines 26-27}.

Claim 26 recites the combination of claims 1 and 5 and therefore rejected for the same reasons.

Claim 27 recites the limitations of claim 2 and therefore rejected for the same reasons.

Claim 28 recites the limitations of claim 7 and therefore rejected for the same reasons.

Claims 3-4 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent 6,557,758 {Monico} in view of US Patent 6,398,109 {hereinafter 'Ohki'}, and further in view of US Patent 5,929,760 {hereinafter 'Monahan'}.

In claims 3 and 4, Monico does not disclose providing radio-frequency shielding as claimed. However, providing radio-frequency shielding is conventional in automated preparation of radio-frequency devices (i.e. RFID tag) for distribution as evidenced by Monahan. Monahan teaches that it is necessary to provide radio-frequency shielding if several radio-frequency devices are following one another in close succession during movement along a conveyor of a preparation device because during said movement, signal degradation may occur resulting from noisy environment {Monahan, col. 1, lines 46-55}. In this case, although reading or writing is still possible, if the signal that is read from or written into the RFID tag is degraded, the result is unintelligible. Therefore, it would have been obvious to one of ordinary skill in the art, at the time of applicant's invention, to include shielding as claimed, in the system of Monico because, as taught by Monahan, signal degradation may occur resulting from noisy environment and therefore signals read from or written into the RFID tag is unintelligible.

Claims 11-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent 6,557,758 {Monico} in view of US Patent 6,398,109 {hereinafter 'Ohki'}, and further in view of US Patent 5,776,278 {hereinafter 'Tuttle et al}'.

In claim 11, Monico does not disclose, "the plurality of such radio-frequency devices comprises receiving a reel that includes the plurality of such radio-frequency devices". However, the storage of radio-frequency devices on a reel (i.e. take-up reel as claimed) for supporting a plurality of radio-frequency devices is conventional as evidenced by Tuttle {Tuttle, col. 11, lines 11-14+}. Storing the radio-frequency device on a reel is advantageous because it makes it compatible to high-speed manual or automated product dispensing and uses {Tuttle, col. 11, lines 14-18+}. Such dispensing and use includes mail and package shipping and handling, as suggested by Tuttle {Tuttle, col. 16, lines 9-14+}. Therefore, at the time of applicant's invention, it would have been obvious to one of ordinary skill in the art to include the "radio-frequency devices stored on a reel" of Tuttle in the "package shipping and handling" of Monico because, as taught by Tuttle, it makes it compatible to high-speed manual or automated product dispensing and use (i.e. package shipping and handling).

In claim 12, the method recited in claim 11 further comprising cutting the reel between radio-frequency devices to separate the radio-frequency devices {Tuttle, col. 11, lines 19-20+}.

Claims 13-15 and 23-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent 6,557,758 {Monico} in view of US Patent 6,398,109 {hereinafter 'Ohki'}, and further in view of US 200310057276 {hereinafter 'Appalucci et al}'.

Claims 13 and 15 recites the method of claim 1 except Monico does not disclose the method of practicing the combination of RFID devices and magnetic-stripe cards, as claimed. However, the combination of RFID devices and magnetic-stripe cards are conventional as evidenced by Ohki and/or Appalucci. Ohki teach of a method for automated package handling system as shown in Figure 1 comprising: receiving a plurality of magnetic-stripe cards 31 in a "sending trade A" station {see Ohki, col. 3, lines 51-53+; col. 4, lines 27-30+}; reading, at a third station (i.e. shown as conveying trade B in Figure 1), an identification of each of the plurality of magnetic-stripe cards from a magnetic stripe comprised by the magnetic-stripe card {see Ohki, col. 4, lines 52-60+}; and determining the radio-frequency identification code to be assigned to a corresponding one of the radio-frequency devices wherein the package (i.e. bag 30 or 6) further contains the magnetic-stripe card corresponding to the each of the radio- frequency devices {see Ohki, col. 5, lines 31-44+}. Ohki teaches that the combination of RFID devices (i.e. non-contact IC card 1) and magnetic-stripe card 31 is advantageous because information about packages when sequentially moved from a first station (i.e. Sending Trade A) to a third station (i.e. Receiving Trade C) can be utilized at the same time maintaining a high degree of secrecy {see Ohki, col. 1, lines 52-57+}. Obviously, the package will be delivered to a destination without handlers knowing the contents of the package. It would have been obvious to one of ordinary skill in the art, at the time of applicant's invention, to include the combination of RFID devices

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and magnetic-stripe cards of Ohki in the system of Monico because, as taught by Ohki, information about packages when sequentially moved from a first station (i.e. Sending Trade A) to a third station (i.e. Receiving Trade C) can be utilized for delivery of the package at the same time maintaining a high degree of secrecy regarding contents of the package.

Ohki does not disclose "the assignment or encoding of the radio-frequency identification code to a corresponding one of the radio-frequency devices is determined from the identification of the each of the plurality of magnetic-stripe cards". However, Ohki teaches that the magnetic stripe card (tag 31) contains data (code) as a reference when mechanically sorting and managing the package {see Ohki, col. 3, lines 44-49+}. Further, Appalucci, in an analogous art, teaches that the magnetic-stripe card (26) used as a primary identifier (i.e. primary identification code) while the radio-frequency device (28) used as a secondary identifier (i.e. radio-frequency identification code) is advantageous because it ensures that the information encoded is accurate and valid {see Appalucci, paragraph [0034]}. Therefore, it would have been obvious to one of ordinary skill in the art, at the time of applicant's invention, to assign or encode radio- frequency identification code to a corresponding one of the radio-frequency devices determined from the identification of the each of the plurality of magnetic-stripe cards in the system of Ohki because, as taught by Appalucci, it ensures that the information encoded on both the magnetic-stripe card and RFID tag is accurate and valid.

Claim 14 recites the limitations of claim 7 and therefore rejected for the same reasons.

Claim 23 recites the limitations of claim 13 and therefore rejected for the same reasons.

Claim 24 recites the limitations of claim 2 and therefore rejected for the same reasons.

Claim 25 recites the limitations of claim 10 and therefore rejected for the same reasons.

#### **(10) Response to Argument**

A. With respect to Claims 1, 2, 5-10 and 26-28, the appellant argues on section A, page 5 to page 6, that Monico in view of Ohki did not taught or suggested all limitations of the claims. Particularly, the appellant argues that Monico did not disclose “sequentially moving each of the RF devices to a plurality of stations of a preparation device”.

In response to appellant’s arguments, Monico discloses a method of handling a product by following procedures: (a) Installing a conventional RFID tag in the product. (b) Providing the product with RFID tag in a package. (c) Imaging human-readable address information directly on the package or imaging human-readable address information on insert/label. (d) encoding the RFID tag with at least one of shipping and tracking data (column 3 lines 6 to 47; see Figure 1). Clearly, the method of handling a product is provided with one of each of the steps or procedures. Furthermore, typically, one of each of these procedures are operated in a station or practiced substantially simultaneously by a computer (15) (column 3 lines 6 to 47; see Figures 1 and 2). One of ordinary skill in the art would understand that moving from step/procedure of installing a conventional RFID tag in the product to the next step/procedure of providing the product with RFID tag in a package is sequentially by either manually or automatically. Clearly, each of these procedures operated in a place or position in the steps is assigned to stand. In other words, each of the RFID tag products moving from one station to other stations sequentially. The appellant argues that the steps of Monico can be nothing more than procedures performed by

manual fashion. It is noted that the claimed method of claims 1, 23 and 26 do not differentiate from a manually performed method. The stations of the claims could be assembly line stations where a person performs the claimed step. Additionally it is noted that Ohki discloses machines at stations to perform certain tasks, as is well known in the assembly and manufacturing arts. It is noted that the claimed stations are not claimed in any manner as to the order of steps performed.

Additionally, Ohki discloses that information about an article to be carried is written into a non-contact type IC card (1) by a reader/writer (2), and the IC card (1) into which the information has been written is accommodated in a carrying bag to which a tag is provided and a paper-made slip is attached, and the carrying bag is stuck to the article to be carried on a first station (i.e. Sending Trade A). On a next station (i.e. Conveying Trade B) collects the article to which the carrying bag is stuck so as to convey it to a desired receiving trade. The information written into the IC card (1) carried together with the received article is read by the reader/writer (4) on another station (i.e. a Receiving Trade C) (column 2 line 53 to column 3 line 2; see Figure 1). Clearly, the RFID IC card attached to an article is sequentially moving from one station to plurality of stations of a preparation device and first station (i.e. Sending Trade A) is different from other stations (i.e. Conveying Trade B or Receiving Trade C). The appellant argues that the stations of Ohki are parts of an entire distribution system. The claims do not differentiate against a distribution system meeting the claimed method steps.

The appellant also argues that there would be no reason for a person of skill in the art to modify Monico in the manner proposed.

In response to Appellant's argument that there is no reason to combine the references, the Examiner recognizes that references cannot be arbitrarily combined and that there must be some reason why one skilled in the art would be motivated to make the proposed combination of primary and secondary references. *In re Nomiya*, 184 USPQ 607 (CCPA 1975). However, there is no requirement that a motivation to make the modification be expressly articulated. The test for combining references is what the combination of disclosures taken as a whole would suggest to one of ordinary skill in the art. *In re McLaughlin*, 170 USPQ 209 (CCPA 1971).

Monico discloses a method of a retail products be manufactured with a passive tag embedded (with read/write capability) into the produce or packaging as a normal part of the manufacturing process allowing the massive proliferation of RFID system use. Sequentially moving each of the RFID devices to a plurality of stations of preparation devices (column 3 lines 6 to 48; see Figure 1). Ohki discloses a method for automated package handling system wherein a second station is different from a first station (column 5 lines 53 to 59; see Figure 1). Therefore, it would have been obvious to one of ordinary skill in the art, at the time of applicant's invention, to include "labeling at a second station different from the first station" in the direct to package printing system with RFID read/write capability of Monico because using a different station for preparation of packaging in printing system would maintain a high degree of secrecy.

**B.** With respect to Claims 3 and 4, the appellant argues on section B, page 7, that the claims be patentable over the cited art by virtue of that dependence.

Monico in view of Ohki discloses all limitations of the claim 1 as discussed above, therefore, Claims 3 and 4 are not to patentable.

**C.** With respect to Claims 11 and 12, the appellant argues on section C, page 7, that the claims be patentable over the cited art by virtue of that dependence.

Monico in view of Ohki discloses all limitations of the claim 1 as discussed above, therefore, Claims 11 and 12 are not to patentable.

**D.** With respect to Claims 13-15 and 23-25, the appellant argues on section D, page 7, that the claims be patentable over the cited arts by virtue of that dependence.

Monico in view of Ohki discloses all limitations of the claim 1 as discussed above, therefore, Claims 13-15 are not to patentable. Furthermore, Claims 23-25 are rejected for the same reasons as discussed above and same as rejected claim 13.

Furthermore, Appalucci teaches that the magnetic-stripe card (26) used as a primary identifier (i.e. primary identification code) while the radio-frequency device (28) used as a secondary identifier (i.e. radio-frequency identification code) is advantageous because it ensures that the information encoded is accurate and valid {see Appalucci, paragraph [0034]}. Therefore, it would have been obvious to one of ordinary skill in the art, at the time of applicant's invention, to assign or encode radio- frequency identification code to a corresponding one of the radio-frequency devices determined from the identification of the each of the plurality of magnetic-stripe cards in the system of Ohki because, as taught by Appalucci, it ensures that the information encoded on both the magnetic-stripe card and RFID tag is accurate and valid.

**(11) Related Proceeding(s) Appendix**

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

NN

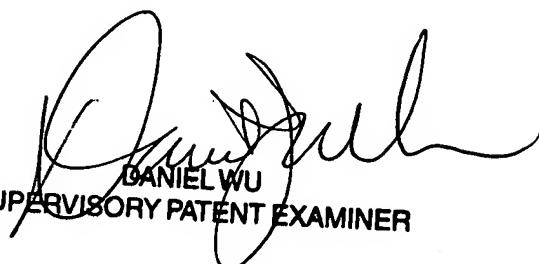


November 7, 2007

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